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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

RECEIVED

JUN 08 2004

OFFICE OF PETITIONS

First named inventor: DAVIDE GRASSETTI

Application No.: 10/044,463

Filed: JANUARY 10, 2002

Art Unit:

Examiner:

Title: METHOD OF IMMUNOMODULATION USING THIONE FORMING DISULFIDES

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX: (703) 872-9306

NOTE: If information or assistance is needed in completing this form, please contact Petitions information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee --required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.
☒ Other than small entity - fee \$ 65 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):
☐ has been filed previously on _____
☒ is enclosed herewith.

B. The issue fee of \$ _____
☒ has been paid previously on JANUARY 10, 2004
☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

MAY 30, 2004
Date

DAVIDE GRASSETTI
Signature

Telephone

Number (209) 532-4535

DAVIDE GRASSETTI
Typed or printed name

19810 PEPPERMINT FALLS ROAD
Address

Enclosures: ☒ Fee Payment☐ Reply☐ Terminal Disclaimer Form☒ Additional sheets containing statements establishing unintentional delay☐ Other: _____

JAMESTOWN CA 95327
Address

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

6/1/04
Date

Richard Grassetti
Signature

Richard Grassetti
Type or printed name of person signing certificate



Davide R. Grassetti
19810 Peppermint Falls Road
Jamestown, CA 95327
Tel. & FAX 209 532-4535

RECEIVED
JUN 08 2004
OFFICE OF PETITIONS

STATEMENT IN SUPPORT OF PETITION FOR REVIVAL OF APPLICATION OF
DAVIDE GRASSETTI AND CAMILLO MORO

Application No. 10/044,463
Filed : January 10, 2002
Title of Invention: METHOD OF IMMUNOMODULATION
USING THIONE FORMING DISULFIDES

Introduction

This statement is intended to clarify and respond to issues raised in your Dismissal letter dated May 18, 2004, and explain the unintentional delay in providing the PTO with the documents necessary to process the patent. Specifically, this letter documents failures of our previous patent attorneys, Morrison and Foerster (MoFo), to supply your office with required documents, resulting in unintentional abandonment of the above-referenced patent, and our efforts to remedy those failures. It also addresses an apparent inadvertent shortening of the response period to your previous notice by your office (see Footnote 1).

Identification of, and Efforts to Remedy, Document Deficiencies

Moro Assignment: We first learned that the U.S.P.T.O. was not in possession of Moro's Assignment in favor of Grassetti from your letter of March 23, 2004. This assignment was executed on February 4, 2002, and sent to MoFo together with Moro's Declaration and Declaration of small entity status. We enclosed copies of all those documents in our response to your Dismissal dated March 23, 2004. A few days after we sent you copies of the Moro documents, we spoke to Denise Caldwell, Patent Systems & Process Manager at MoFo about another matter, and she told us that assignments had to be notarized and recorded. We phoned Mr. Moro immediately upon learning this, and he forwarded the documents to you for arrival within the two-month response period¹.

Grassetti Declaration and Small Entity Declaration: With respect to the Grassetti Declaration and Small Entity Declaration, we were not aware of such omissions until your Dismissal letter of May 18, 2004. In early 2002, MoFo filed the subject Application

¹ Your office did not provide us with the full two-month (61-day) response period allowed in your March 23 letter. Your previous communication was mailed on March 23, 2004, not on March 15, as stated in your May 18, 2004 letter. Therefore the response time was not two months, but 8 days short of two months. This is a critical difference because our responses assumed the full two-month response period. For example, Mr. Moro sent you a new Assignment, notarized and including the fee, by UPS. on or about May 13, 2004, which allowed ample time for its delivery prior to the close of that period, but not in the shortened period.

on our behalf. The NOTICE OF MISSING PARTS reached us in early April of 2002, whereupon Davide Grassetti executed the Declaration and Small Entity Declaration and sent them to MoFo on or about April 11, 2002. These were accompanied by a \$65 check to the PTO, which MoFo returned because they preferred to pay from their own account. When MoFo returned the check but did not return the documents to us, we assumed that those documents had been transmitted to your office as indicated by Attachment A (letter from MoFo accompanying returned check). When we learned from your office that MoFo had not forwarded the documents to the U.S.P.T.O., we acted to remedy the situation. We have included copies of the Grassetti Declaration and Declaration of Small Entity executed on April 9, 2002 as attachments to this letter, as well as a \$65 check for your processing fees.

As you can see, we have acted with due diligence to remedy all of these deficiencies and submit all requisite documents as soon as we became aware that they had not been submitted by MoFo. We sincerely hope that there are no other missing documents. Please inform us directly if there are any such additional missing documents.

Presumed Representation by Patent Attorneys

We retained the firm of Morrison and Foerster in 2000 to prepare and prosecute the patent in question. Mofo was fully responsible for assuring that all patent filings with your office were complete and accurate. From 2000 through mid-2002, MoFo was paid over \$70,000 for their services on this patent. In late April 2002, in an effort to control spiraling costs, we wrote MoFo requesting that they restrict their services to strictly necessary items, (see Attachment B) whereupon, on May 7, 2002, MoFo replied that they would cease providing services to us. (see Attachment C). We did not agree to this unilateral cessation of services, as evidenced by our not signing Ms. Monroy's unilateral disengagement letter. In any case, MoFo's unilateral disengagement occurred well *after* our February 2002 submittal of the required documents to them for transmittal to your office and *after* our subsequent submittal of documents requested in your NOTICE OF MISSING PARTS to MoFo for transmittal to your office on or about April 11, 2002 (see attached Declarations).

In 2002, and until recently, Grassetti and Moro, relying on the good name and reputation of MoFo, assumed that MoFo had forwarded all documents executed by Grassetti to the U.S.P.T.O. No reasonable person, when using and paying for the services of a large and reputable law firm would suspect otherwise. Therefore we had no reason to believe that those documents had not been transmitted to your office in a timely manner. This unknown failure of our attorneys resulted in the unintentional abandonment of this patent.

Other Considerations

Dr. Grassetti is now 83 years old, and legally blind. He was hospitalized from April 7, 2004 through April 12, 2004 with kidney failure and was subsequently confined to his bed for another two weeks. Obviously, during his hospitalization and subsequent bedridden period, Dr. Grassetti was unable to deal with these patent issues. The patents are no longer his most precious possessions. His health and family are. But the patents are his legacy to his family and to the world. Small clinical trials in the Congo have shown these thione-forming disulfides to be useful in the treatments of AIDS patients. Therefore, this patent application may turn out to be very important.

Conclusions

For all the above reasons we respectfully request and petition that Grasseti be allowed an extension of time of not more than two months from May 18, 2004, to complete this application, and the enclosed petition will be accepted by your office.

Enclosures

Copies of the Grasseti Declaration and Declaration of Small Entity status, dated April 9, 2002.

Check to the Commissioner of Patents in the amount of \$65

Letter of Hsieh-Newton, dated April 18, 2002

Copy of letter requesting cost controls, dated April 23, 2002

Copy of letter from Gladys Monroy, dated May 7, 2002

cc:

Joan Parades
Office of Senator Barbara Boxer
1700 Montgomery Street, Suite 240
San Francisco, CA 94111

Denise R. Caldwell
Patent Systems & Process Manager
Page Mill Road
Palo Alto, CA 94304-1018

Attchd (A)

MORRISON & FOERSTER LLP

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April 18, 2002

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TShieh-Newton@mofa.com

Privileged and Confidential

By Overnight Delivery

Davide and Mine Grassetti
19810 Peppermint Falls Road
Jamestown CA 95327

Dear Dr. and Mrs. Grassetti:

We have received your check #4991 in the amount of \$65.00 made payable to U.S. Patent and Trademark Office. Unfortunately, we will have to return this check to you. When Morrison and Foerster submits the necessary documents to comply with Notice of Missing Parts, the firm has an account from which the USPTO draws their fees. The client is then billed in turn for the USPTO fee and Morrison and Foerster's fixed fees. The fee for missing parts is \$65 and Morrison and Foerster's fixed fees for services in preparing documents for Missing Parts and the accompanying services (e.g., docketing Notice of Missing Parts, reviewing executed documents, etc.) is \$225.

If you wish, you may send a check in the amount of \$290 made payable to Morrison and Foerster. We will put this amount in trust to cover the expenses for the Missing Parts or you may wait until the next billing statement is sent to you at which time the entire amount due to Morrison and Foerster can be paid.

Thank you in advance for your cooperation.

Yours truly,



Terri M. Shieh-Newton, Ph.D.
Patent Agent

Enclosure

cc: Gladys Monroy
Pamela Darr

pa-685726



Attachment (B)

Ms. Gladys Monroy
Morrison and Foerster

April 23, 2002

SUBJECT: IMPLEMENTATION OF COST CONTROL POLICIES FOR GRASSETTI PATENT WORK

Dear Ms. Monroy;

As you know, the project budget for CPDS and associated compounds, including patenting work, is very limited. In order to maximize the benefits of our limited funding, we are instituting a number of cost control and monitoring measures for this project. With respect to Morrison and Foerster's activities, we are implementing the following measures which will be effective as of May 1, 2002.:

1. **Prior Work Authorization:** Morrison and Foerster shall not conduct any patenting work without prior verbal or written authorization from Davide or Mine Grasseti, or their designated representatives (Client). The only exception to this policy shall be for emergency situations where patents would be endangered, and the client can not be reached or does not respond in a timely manner. All work authorization requests shall include budget ceilings. Those ceilings shall not be exceeded without the prior authorization of the Client.
2. **Direct Payment of Patent Fees:** The Client shall be given the option to pay patent fees directly to US and foreign patent offices. Morrison and Foerster shall notify client in a timely manner of pending or anticipated fees, and shall provide the Client the option of paying such fees directly. Client will provide Morrison and Foerster with proof of payment of such fees for your files. As an alternative, Morrison and Foerster shall have the option of paying such fees with a mark-up of no more than 15% for processing.
3. **Billing Activities:** Client will not pay for any discussions with Morrison and Foerster legal staff regarding fees or billings. Payment shall be limited to professional services actually conducted by Morrison and Foerster on Client's behalf. Administrative services, including all billing activities and discussions regarding billings are considered part of Morrison and Foerster's overhead.
4. **Errors, Omissions, and Training:** Client will not pay for any work effort required to correct any errors or omissions on the part of Morrison and Foerster staff unless the need for such work results wholly or in part from Client's activities. Similarly, Client will not pay for additional or corrective work efforts associated with training of Morrison and Foerster staff. Such corrective work efforts and training are considered to be included in Morrison and Foerster's overhead.

We have enjoyed working with you and are pleased with your technical efforts on our behalf, and trust that these cost control measures will not be problematic. Please feel free to contact me at (209) 532-4535 if you have any questions or comments regarding these cost control policies.

Sincerely

Davide Grassetti

Attached (C)

MORRISON & FOERSTER LLP

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May 7, 2002

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**Via Facsimile
Confirmation by FedEx**

Davide R. Grassetti
1980 Peppermint Falls Road
Jamestown, CA 95327

Re: Disengagement of Legal Services

Dear Davide:

We received your letter dated April 23, 002 on May 2, 2002. Due to the implementation of your cost control policies effective May 1, 2002, it has become necessary for Morrison & Foerster LLP to withdraw as your counsel in connection with all Intellectual Property matters effective June 1, 2002.

Please consider this our demand for payment in full by May 31, 2002 of all outstanding invoices in the amount of \$11,361.76 along with unbilled professional services as well as disbursements to associates and government agencies as of April 30, 2002, in the amount of \$1,657.15. The total due to Morrison & Foerster is \$13,018.91. I am attaching for your information our current Accounts Receivable report which indicates all outstanding invoices.

If you do not comply with our request for payment in full of your outstanding balance with Morrison & Foerster in the amount of \$13,018.91, your account will be sent to collection for recovery.

Also, please advise by May 20, 2002 the name and address of the law firm that will be representing you in the above matters, and we will arrange to transfer said files to them. If we do not hear from you by May 20, 2002, it will be deemed your approval that you wish the files to be transferred to you directly at 19810 Peppermint Falls Road, Jamestown, CA 95327 and that you assume all responsibility for all actions relating to the monitoring and prosecution of the Intellectual Property matters.

MORRISON & FOERSTER LLP

Davide Grassetti

May 7, 2002

Page Two

It is requested that you confirm your concurrence with the arrangements set forth above for our withdrawal of legal counsel by signing in the place provided below and returning to us one copy of this letter by return facsimile by May 20, 2002.

Sincerely yours,



Gladys H. Monroy

Enclosure

cc: Pam Darr, Accounting Dept.
Docket Dept.
Annuity Dept.

Confirmed this _____ day of _____, 2002.

By: _____

Title: _____